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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,929	08/08/2001	Luis Mendez Llatas	B-3406DIV 618993-3	5244

7590 07/28/2004

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EXAMINER

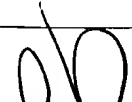
BROWN, JENNINE M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/924,929	Applicant(s) LLATAS ET AL.	
	Examiner Jennine M. Brown	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/08/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/28/02, 8/8/01</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-17, 21, 24-25 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang (US 6136742).

Chang discloses a heterogeneous catalyst with a metallocene fitting the instant claim 14 structure (I), where halogens are attached to the metal of the metallocene which is one of group 3-6 transition metal and has a bridged dicyclopentadienyl ligand structure where the bridging group may be made of more than one atom and has at least one of silicon, germanium or tin in its skeleton (col. 2, l. 51 – col. 4, l. 67; col. 8, l. 10-49; col. 25, l. 6-10). A method of making and using the catalyst are also disclosed (col. 1, l. 53-67; col. 14, l. 7 – col. 23, l. 35).

Claims 14-17, 21, 24-25 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuber, et al. (US 6255506 B1).

Kuber, et al. disclose a heterogeneous catalyst with a metallocene fitting the instant claim 14 structure (I), where halogens are attached to the metal of the metallocene which is one of group 3-6 transition metal and has a bridged

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dicyclopentadienyl ligand structure where the bridging group may be made of more than one atom and has at least one of silicon, germanium or tin in its skeleton (col. 3, l. 3 – col. 4, l. 10; col. 10, l. 20-25). A method of making and using the catalyst are also disclosed (col. 4, l. 11 – col. 10, l. 19).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-29 of US 6753436 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims would be considered the genus for the patented species. Both claims are drawn to catalysts which are supported on a porous support, therefore they are both heterogeneous catalysts. Furthermore the metals claimed are within groups 3-6 of the Periodic Table of the Elements and the claimed ligands are bridged cyclopentadienyl groups where the bridging group can be silicon or germanium.

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It would have been obvious to one of ordinary skill in the art to modify the number of cyclopentadienyl ligands with bridging groups to improve upon the molecular weight distribution of the polymer as well as the co-monomer incorporation and tacticity of the polymer.

Claims 14-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of US 6018064.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to the same catalyst formulation but the instant claims are drawn to a heterogeneous catalyst rather than the patented homogeneous catalyst. It would have been obvious to one of ordinary skill in the art to choose an appropriate support for the patented catalyst because it is easier to recycle a catalyst if it is heterogeneous rather than homogeneous.

Claims 14-29 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of US 6278009 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because when one combines the primary claim with claim 5, the scope of the patented claim becomes identical to that of the instant application.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (571) 272-1364. The examiner can normally be reached on M-F 8:00 AM - 6:00 PM; first Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (571) 272-1700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jmb



Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700